



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,730	10/29/2003	Mark Hoffman	1804.004US1	6344
21186	7590	04/10/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 121 S. 8TH STREET SUITE 1600 MINNEAPOLIS, MN 55402			CARR, DEBORAH D	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,730	Applicant(s) HOFFMAN ET AL.	
	Examiner Deborah D. Carr	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-70 is/are allowed.
- 6) ☒ Claim(s) 71-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 14--15, filed 27 January 2006, with respect to rejections made under 35 USC§101 & 35 USC§112,2nd paragraph have been fully considered and are persuasive. The rejection of claims 1-96 has been withdrawn.
2. The following rejection/objections have been deemed proper.

Claim Objections

3. Claims 71-89, 95-96 is objected to as being drawn to compounds in the context of a product-by-process claim format. The objection is based on the fact that the compounds produced by the process are definite as to their meaning. As such, claims to the compounds can stand-alone. Product-by-process claim language is reserved for situations where the compound cannot be claimed in a definite manner. The instant application does not fall into this category, as the compounds are definite. Further, there is no showing that the process of making imparts new and unobvious properties to the compounds themselves.

Therefore, product-by-process claims 71-96 will be treated as compound claims for the purpose of this examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1621

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 71-74, 77-78, 85, 87, 95-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Khachik (US Pat. 5,382,714).

US'714 teaches lutein compounds and their use in pharmaceutical and nutraceutical formulations.

6. Claims 71-76, 85-86, 95-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thomas (US Pat. 5,811,446).

US'446 teaches lutein compounds, their use in pharmaceutical formulations and the treatment of ulcers.

7. Claims 71-80, 85, 89, 95-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Howard et al. (US Pat. 6,218,436).

US'436 teaches lutein compounds, their use in pharmaceutical formulation and in the treatment of macular degeneration.

8. Claims 71-76, 80-85, 95-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Murad (US Pat. 5,804,168).

US'168 teaches lutein compounds and their use in pharmaceutical and nutraceutical formulations.

9. Claims 71-85, 95-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Soudant et al. (US Pat. 5,712,311).

US'311 teaches lutein compounds and their use in pharmaceutical and nutraceutical formulations.

10. Claims 71-75, 77-78, 81-83, 90-96 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Antoshkiw et al. (US Pat. 3,998,753).

US'753 teaches lutein compounds, their use in pharmaceutical, nutraceutical, cosmetic and dietary formulations.

Allowable Subject Matter

11. Claims 1-70 are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

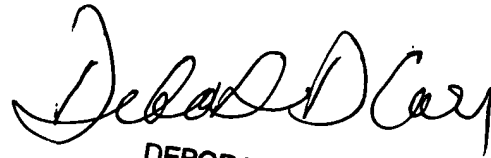
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

Art Unit: 1621

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).

A handwritten signature in black ink, appearing to read "Deborah D. Carr". The signature is fluid and cursive, with the first name "Deborah" and last name "Carr" being more prominent.

DEBORAH D. CARR
PRIMARY EXAMINER

ddc